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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OPHIRA ROSOLIO AHARONSON and DOV AHARONSON

Appeal 2009-004859
Application 08/729,341
Technology Center 2600

Before, ROBERT E. NAPPI, JOSEPH F. RUGGIERO, and SALLY C.
MEDLEY, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

This is a decision on appeal under 35 U.S.C. § 134(a) of the final rejection of claims 1-11, 20-42, and 57-58.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm the Examiner's rejections of these claims.

INVENTION

The invention is directed to a system that integrates a scanner, copier, and fax with a standard keyboard. *See Spec:* 1-7. Claim 1 is representative of the invention and reproduced below:

1. A system comprising a document-driven scanning input device communicating with a computer, said input device comprising scanning means for generating image data representing the image of a document, and means, responsive to placement of a document by a user, for drawing the document into scanning relationship with said scanning means so that said scanning means generates image data representing the image of said document, wherein said placement alone is sufficient to initiate said drawing, and said computer comprising means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data.

REFERENCES

Cotte

US 5,499,108

Mar. 12, 1996

² Claims 12-19 and 43-56 were cancelled in response to the Non-final Office Action, mailed November 7, 2002.

REJECTION AT ISSUE

Claims 1-11, 20-42, and 57-58 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Ans. 3-5.

ISSUES

Appellants argue on pages 10-25 of the Appeal Brief that the Examiner's rejection of claims 1-11, 20-42, and 57-58 under 35 U.S.C. § 112, first paragraph, is in error. Appellants choose claim 1 as representative of the group comprising claims 1-11, 20-42, and 57-58. App. Br. 18. Appellants argue that their Specification contains support for both (1) a means for placing a document into a scanner to initiate scanning of the document; and (2) a computer comprising means for displaying user-selectable options for processing image data in response to placement of the document into the scanner. App. Br. 14-16.

Thus, with respect to claim 1, Appellants' contention presents us with two issues: Did the Examiner err in finding that Appellants' Specification does not contain (1) a means for placing a document into a scanner to initiate scanning of the document; and (2) a computer comprising means for displaying user-selectable options for processing image data in response to placement of the document into the scanner?

PRINCIPLES OF LAW

35 U.S.C. § 112, first paragraph, states that “[t]he specification shall contain a written description of the invention . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, . . . to make and use the same” To satisfy the description requirement, one must show “possession” of the invention by describing the claimed invention, with all its claimed limitations, using descriptive means such as words, structures, figures, diagrams, formulas, etc. *See Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). While the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims, the specification must contain an equivalent description of the claimed subject matter. *Id.*

If an applicant for patent employs means-plus-function language in a claim, the applicant is required to “set forth in the specification an adequate disclosure showing what is meant by that language.” *In re Dossel*, 115 F.3d 942, 946 (Fed. Cir. 1997) (*quoting In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994)).

“‘When interpretation is required of a claim that is copied...the copied claim is viewed in the context of the patent from which it was copied.’” *Agilent Technologies, Inc. v. Affymetrix, Inc.*, 567 F.3d 1366, 1374 (Fed. Cir. 2009) (*quoting In re Spina*, 975 F.2d 854, 856 (Fed. Cir. 1992)).

FINDINGS OF FACT (FF)

Cotte

1. Cotte discloses a system wherein upon placement into an input device, sensors trigger a scanning mechanism to draw a document through a scanner. Col. 10, ll. 28-34.
2. At the same time the document is being scanned and as a result of the document being placed into the input device, the device sends a signal to a host that generates a drop-down menu that is displayed on a computer monitor. Col. 5, ll. 45-47 and col. 10, ll. 42-45.
3. The menu presents options to the user that include: FAXing the document, sending the image in an email, printing the image, pasting the image into a memory clipboard, archiving the image, performing word processing on the image, etc. Col. 10, ll. 45-57.

Appellants' Specification

4. Appellants' Specification discloses a "master mode" wherein a computer is the "slave" device for printing and displaying communications. A keyboard/scanner is the "master" device. Spec. 23.
5. The keyboard operates as a regular keyboard until a document is inserted into a feeding slot. At this point, sensors sense the document and the keyboard becomes a "master" device where it is converted into a fax or copy machine. The document is subsequently scanned and stored in a "spool" directory. Spec. 17-18 and 26.

6. In order for untrained individuals to operate the device like a normal FAX or copy machine, the keyboard switches keys from normal operation to predefined functional keys that include “SEND FAX, START COPY, FAST DIAL etc.” Spec. 25.
7. Once a predefined functional key is selected and pressed by the user, the computer may display information that includes: “the dialed number, the transmitted fax status information, and operation instructions.” Spec. 25.

ANALYSIS

First Issue

Appellants’ arguments have persuaded us of error regarding the first issue of the Examiner’s rejection of claim 1. Claim 1 recites “means, responsive to placement of a document by a user...wherein said placement alone is sufficient to initiate said drawing.” Since, as here, the claims contain means-plus-function language, we look to the Specification to determine the meaning of the claim limitations. *See In re Dossel*, 115 F.3d 946. Additionally, since this claim limitation was copied from the Cotte reference, we use the Cotte Specification to interpret the meaning of Appellants’ claim limitation. *See Agilent*, 567 F.3d 1374.

The structure which corresponds to the means responsive to placement of a document, therefore, is a scanning device that interprets signals from paper sensors. FF 1. Once the document is inserted into the input device, it is drawn into the scanner and scanned. FF 1. Appellants

argue that their Specification discloses this same limitation. App. Br. 14-15. We agree.

Appellants' Specification indicates that as a document is placed in the scanner, the keyboard is switched to the master device and the document is automatically scanned and stored. App. Br. 14-15. Therefore, we agree that Appellants' Specification contains support for the means for drawing the document through the scanner in response to the placement of the document into the scanner. Additionally, the Examiner concedes that Appellants' Specification contains this limitation. Ans. 5-6. Therefore, we do not sustain the Examiner's rejection with respect to the "means responsive to placement of a document...." as Appellants' Specification does contain support for automatically scanning a document in response to the placement of the document.

Second Issue

Appellants' additional arguments have not persuaded us of error in the Examiner's rejection regarding the second issue of claim 1. Claim 1 additionally recites "said computer comprising means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data." As noted above, we look to the Specification to determine the meaning of the means-plus-function claim limitations. *See In re Dossel*, 115 F.3d 946. Again, we use the Cotte Specification to interpret the meaning of Appellants' claim limitation since the claim was copied from Cotte. *See Agilent*, 567 F.3d 1374.

Therefore, the computer comprising means for displaying consists of a computer monitor. FF 2. Also, the user-selectable options for image

processing consist of faxing the image, sending the image in an email, pasting the image into a clipboard memory, sending the image to a printer, archiving the image, or performing word processing on the image. FF 3. These options are displayed as a result of the placement of the document into the scanner. FF 1, 2.

The Examiner finds that Appellants' Specification does not disclose the limitation of automatically displaying user-selectable options in response to the placement of the document. Ans. 5-6. Appellants argue that in their Specification the operation instructions are equivalent to user-selectable options for processing said image data. App. Br. 17. Additionally, Appellants argue that these operating instructions are displayed as a result of inserting a document into the scanner. App. Br. 17. We disagree.

Appellants' Specification discloses a keyboard that changes over to a master input device when a document is inserted into the scanner. FF 4, 5. This mode of operation allows untrained individuals to operate the device like a normal FAX or copy machine. FF 6. Once a function, i.e., SEND FAX, START COPY, FAST DIAL, etc., is selected and pressed by the user operating the keyboard, the computer display may display "the dialed number, the transmitted fax status information, and operation instructions." FF 6, 7. Even though Appellants' Specification does not sufficiently disclose the meaning of "operation instructions," nowhere in the Specification are these "options" described as relating to processing the image data, nor are the "options" displayed as a result of the document insertion. Rather, these "options" are displayed after the user has selected the desired image processing for the data using the keyboard. Therefore, we sustain the Examiner's rejection of claim 1 as not containing support for

displaying user-selectable options for processing said image data upon placement of a document into a scanner. We also sustain the rejection of claims 2-11, 20-42, and 57-58 which are grouped with claim 1.

CONCLUSION

The Examiner erred in finding that Appellants' Specification does not disclose a means for placing a document into a scanner to initiate scanning of the document.

The Examiner did not err in finding that Appellants' Specification does not contain support for a computer comprising means for displaying user-selectable options for processing image data in response to placement of the document into the scanner.

SUMMARY

The Examiner's decision to reject claims 1-11, 20-42, and 57-58 under 35 U.S.C. § 112, first paragraph, is sustained.

Appeal 2009-004859
Application 08/729,341

AFFIRMED

ELD

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